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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,353	02/10/2004	Phillip Frederick	10557/293163	1160
30559	7590	01/09/2008		
CHIEF PATENT COUNSEL SMITH & NEPHEW, INC. 1450 BROOKS ROAD MEMPHIS, TN 38116			EXAMINER SWIGER III, JAMES L	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/775,353

Applicant(s)

FREDERICK ET AL. CT

Examiner

James L. Swiger

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/18/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/2/2007 has been entered.

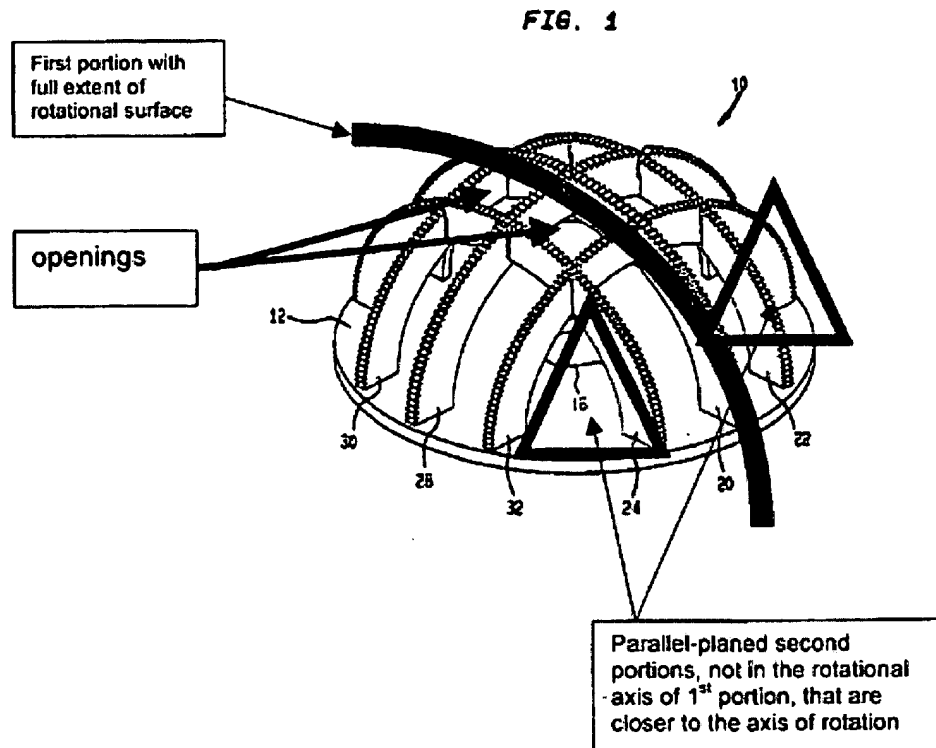
Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Frieze et al. (US 5,775,719). Frieze et al. disclose a reamer having a hollow body having a "general dome shape" (10) forming an inner and outer surface, and is capable of rotating on an axis (16). The device also has a plurality of raised edges for cutting bone (42) or cartilage, and a plurality of openings for the passing the fragments into the interior portion of the reamer (see drawing below). Also shown below is the reamer disclosed by Frieze et al. having a first portion dimensioned as a surface of rotation, and a second portion not forming a surface of rotation that is generally located closer to the

axis of rotation that the first portion. For clarification, the triangular sections represent a portion of the reamer head that may be considered a second portion, separate from the shown first "banded" and rotational portion. These two portions are closer to the location of the axis of rotation (16), than from the extents of the first portion as a rotational surface. *These portions also show at least one side.* Though difficult to show, the two triangles are in planes substantially parallel.



Further, with regards to claim 8, the device of Frieze et al. is capable of use in surgery for either hip replacement or in the acetabulum of an animal or a human.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Lechot (US 2005/0075639). Lechot discloses a device having a hollow body with a surface (12'), a dome shape (fig. 4), a plurality of raised edges for cutting bone or cartilage (fig.

4), and has a plurality of openings for passing fragments of bone into the interior of the reamer (18'). Lechot further discloses a reamer that has a first portion (12') and that also has a second portion (50) that does not form a surface of rotation and is closer to the axis of rotation (since these cut edges form a shortened outer rim of the reamer, closer to the axis). See also Par. 0033. In further discussion, the claims also require at least a SIDE formed by the generally dome-shaped reamer. Despite the absence of metal, arguing that a 'side' is absent or substantially a vacant hole, the fact that the dome-shape has been disturbed by a cut and reshaped, Lechot has created at least a SIDE as required by the claims. Additionally, because this is a "side" this side also does not have cutting edges, as they are limited to the first portion.

The two second portions are substantially parallel, and the raised cutting edges are also confined to the first portion (fig. 4). The device as disclosed is also capable of use in hip replacement arthroplasty or for use in the acetabulum of an animal or human. Also in the device of Lechot, the raised edges may be considered in multiple sectors, divided transversely across the first portion, or horizontally across its diameter, as individual or multiple cutting edges.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-7 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freize '719 in view of Lechot '639. Freize et al. discloses the claimed invention except for a first portion and a second portion wherein the cutting edges are limited to the first portion and the second portion has a side without any cutting edges. As noted above Lechot has what is considered a "side" that inherently does not have cutting teeth. This shape allows for improved cutting, to have a smoother surface (pars. 0030 through 0033). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Freize having at least a separate, second side without cutting teeth in view of Lechot to have better cutting surface and improved entry into the surgical area.

Response to Arguments

Applicant's arguments filed 11/2/2007 have been fully considered but they are not persuasive. With regards to applicant's amendments as filed, it is held that the claimed invention still reads on the prior art of record. It is still noted that Freize et al. still discloses at least two distinct sections, and wherein at least one has a "side." Despite the discussion in the interview dated 11/14/2007, Lechot still discloses and teaches at least a "side." For an analogy, a box with its lid removed is essentially an open space, similar to the side of Lechot. However the top portion of the box, and more specifically the plane defined where the lid would be placed, is still defined as the top of the box, and further may still be broadly defined as one of the sides of the box. Likewise, the side as cut from the hemisphere, is a side of the reamer.

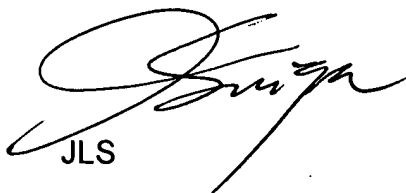
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

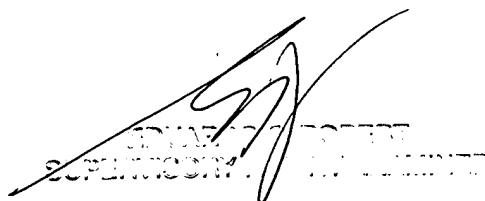
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JLS

1/6/08


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SUPERVISOR